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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,911	01/10/2001	Luke Surazski	13522/43 (99688)	9288
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EXAMINER WONG, BLANCHE				
ART UNIT		PAPER NUMBER		
2619				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/758,911

Applicant(s)

SURAZSKI ET AL.

Examiner

BLANCHE WONG

Art Unit

2619

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on March 28, 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 6, 7, 9-17, 19-29, 31-39, 41-45, 50, 51 and 53-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6, 7, 9-17, 19-29, 31-39, 41-45, 50, 51 and 53-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1,6-7,9-17,19-29,31-39,41-45,50-51,53-66 have been considered but are moot in view of the new ground(s) of rejection.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the steps of "receiving a selection ...", "providing said URL to a protocol server", "placing a call responsive to a selection ...", "routing the entered phone number", "routing a session request ..." (claim 1); and the device of claim 23 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Applicant states "[a]ll claimed elements are shown in FIGS., notably FIG. 2." Amendment and Response to Office Action, p.15, para. 2. Examiner respectfully disagree with Applicant that Fig. 2 shows the entirety of claim 1.

Claim Objections

3. Claims 1,12,21,23,34,43,45,56,62,63,65 are objected to because of the following informalities:

With regard to claims 1,23,45, Examiner suggests spelling out the abbreviations URL and DNS in the claim language.

With regard to claim 1, Examiner suggests replacing "receiving a selection" in line 11 with "receiving, from the caller, a selection" in consistent with line 3.

With regard to claim 12, Examiner suggests spelling out the abbreviation SIP when using it for the first time.

With regard to claim 21, Examiner suggests replacing "a protocol server" in line 2 with "the protocol server" in consistent with claim 1.

With regard to claim 23, Examiner suggests replacing "receiving a selection" in line 11 with "receiving, from the caller, a selection" in consistent with line 3.

With regard to claim 34, Examiner suggests spelling out the abbreviation SIP when using it for the first time.

With regard to claim 41, Examiner suggests replacing "a mapping service" in line 2 with "the mapping service" in consistent with claim 23.

With regard to claim 43, Examiner suggests replacing "a protocol server" in line 2 with "the protocol server" in consistent with claim 23.

With regard to claim 56, Examiner suggests spelling out the abbreviation SIP when using it for the first time.

With regard to claim 62, Examiner suggests replacing "a protocol server" in line 4 with "the protocol server" in consistent with claim 45.

With regard to claim 63, Examiner suggests replacing "a mapping service" in line 2 with "the mapping service" in consistent with claim 45.

With regard to claim 65, Examiner suggests replacing "a protocol server" in line 2 with "the protocol server" in consistent with claim 45.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 1,6-7,9-17,19-29,31-39,41-45,50-51,53-66** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

With regard to claim 1, the steps of the claim do not correspond to Figures. Fig. 2 shows broadly for the first four steps. Figs. 4 shows details of the step of returning a URL. First, the amended step of "transmitting the URL to a mapping service" differs from the disclosure. Specification, p.13, lines 11-12, discloses "...placing a request for information regarding a party to be called ... entering A1's phone number ... A1's number is then routed to mapping service 304". Therefore, it is not the URL, but a phone number, that is transmitted to a mapping service. Furthermore, Examiner notes that in claims 23 and 45, amendment is "requesting [not transmitting] the URL from a mapping service"

Second, Specification discloses the process in Fig. 5 preceding the process in Fig. 6. Fig. 5 shows details of the step of providing a URL to a protocol server and Fig. 6 shows details of the step of displaying to said caller one or more connection options. Specifically, Specification, p. 13, line 19, to p. 14, line 10, discloses "[t]he URL is then provided to the protocol server 302, which in turn routes the URL back to the caller ... the caller may now access the URL through the HTTP server 310 ... the HTTP server 310 will present ... the connection options available according to the URL." Therefore, the step of providing a URL to a protocol server comes before the step of displaying to said caller one or more connection options. Similarly in claims 23 and 45.

Third, Specification discloses the process of Fig. 7 preceding the process of Fig. 8. Fig. 7 shows details of the step of routing a session request to the protocol server and Fig. 8 shows details of the step of routing the entered phone number to the protocol server. Specifically, Specification, p. 16, lines 13-14, discloses "... the session request ... will be routed ... through the protocol server 302" and p. 17, line 3, discloses "A1's cell phone number ... to the protocol server." Therefore, the step of routing a session request to the protocol server comes before the step of routing the entered phone number to the protocol server. Similarly in claims 23 and 45.

Fourth, Specification does not disclose the step of "placing a call responsive to said receiving at least one selected connection options by entering a phone number" between the steps of "providing said URL to a protocol server" and "routing the entered phone number to the protocol server". Similarly in claims 23 and 45.

Claims 6-7,9-17,19-22,24-29,31-39,41-44,50-51,53-66 are rejected because they are depended from claims 1 or 23 or 45.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 1,6-7,9-17,19-29,31-39,41-45,50-51,53-66** are rejected under 35

U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 1, it is unclear whether it is "transmitting the URL ..." in line 7 or "transmitting said request" or transmitting a phone number, according to the Specification.

With regard to claim 1, it is unclear what is meant by "similar to" in line 7.

With regard to claim 1, it is unclear who is "receiving a selection" in line 11 because claim 1 is from the point of view of an improved interface according to the preamble.

With regard to claim 6, it is unclear what is meant by "a said" in line 2.

With regard to claims 6,9,19-22, it is unclear when these acts happen in relation to claim 1.

With regard to claim 23, it is unclear what is meant by "similar to" in line 7.

With regard to claim 23, it is unclear who is "receiving a selection" in line 11 because claim 23 is from the point of view of an improved interface according to the preamble.

With regard to claim 28, it is unclear whether the claim depends from claim 3 or 23.

With regard to claim 41, it is unclear whether the claim is a device or method that includes "the act of routing said session request"

With regard to claim 45, it is unclear what is meant by "similar to" in line 9.

With regard to claim 45, it is unclear who is "selecting" in line 13.

With regard to claim 50, it is unclear whether the claim depends from claim 3 or 45.

With regard to claims 50,53,63-66, it is unclear when these acts happen in relation to claim 45.

8. There is insufficient antecedent basis for this limitation in the claim.

Claim 1, line 14, "said receiving at least one selected connection options".

Claim 23, line 14, "said receiving at least one selected connection options".

Claim 45, line 15, "said receiving at least one selected connection options".

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. **Claims 45,50-51,53-66** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. "A program storage device readable by a machine, tangible embodying a program of instructions executable by the

machine ..." is non-statutory subject matter and is not permissible claim language, whereas "computer readable medium storing/encoded with a computer program/software/computer executable instructions" satisfies statutory requirement.

Claims 50-51,53-66 are rejected because they depend from claim 45.

Examiner notes that Specification only briefly discloses machine-readable media and storing instructions. Neither computer readable medium nor computer program or computer executable instructions was disclosed.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BLANCHE WONG whose telephone number is (571)272-3177. The examiner can normally be reached on Monday through Friday, 830am to 530pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edan Orgad can be reached on 571-272-7884. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2619

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Blanche Wong/
Examiner, Art Unit 2619
June 11, 2008

/Edan Orgad/
Supervisory Patent Examiner, Art Unit 2619